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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/934,912	08/22/2001	Nicholas Luke Bennett	031035-87575(3243/FBR)	8428
26304	7590	02/23/2004	EXAMINER	
KATTEN MUCHIN ZAVIS ROSENMAN			MARKS, CHRISTINA M	
575 MADISON AVENUE			ART UNIT	
NEW YORK, NY 10022-2585			PAPER NUMBER	
			3713	
DATE MAILED: 02/23/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/934,912

Applicant(s)

BENNETT ET AL.

Examiner

C. Marks

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>09272001</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Drawings***

The drawings are objected to under 37 CFR 1.83(a) because they fail to show the control means as described in the specification. The drawings should be labeled as to a skilled artisan could immediately recognize the parts. Specifically all the blocks of FIG 2 should be labeled with terms such as CPU, memory, etc. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Objections

Claims 1-2 are objected to because of the following informalities: According to 37 CFR §1.75(i): Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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Claims 1, 3-8, 11 and 13 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Johnston (GB 2253300).

Johnston discloses a gaming machine having a display means and a control means arranged to control images on the display (FIG 5) wherein random events cause the images to be displayed and if a predefined winning event occurs a prize will be awarded. The display means displays a plurality of movable carriers wherein each has at least one polyhedral element with a plurality of faces that are visible at any one time (FIG 5). Each face has indicia on each face and indicia on faces of the polyhedral element that are visible at a rest condition are taken into account for determining winnings.

Regarding claim 3, each carrier has more than one polyhedral element (FIG 5).

Regarding claim 4, the polyhedral elements are spaced from each other such that only one element is visible at a time in each display window when the carrier is at rest. Two polyhedral will never share the same viewing window (FIG 4a).

Regarding claim 5, the game is a spinning reel game.

Regarding claim 6, the carrier is in the form of a spinning reel carrying at least one polyhedral element (FIG 5).

Regarding claim 7, each element is fixed position with respect to its associated carrier.

Regarding claim 8, each element is also movable with respect to their associated fixed position on their carriers.

Regarding claim 11, the indicia are standard symbols related to the game.

Regarding claim 13, the element is substantially cubic in shape.

Claims 1-6, 8-11 and 13 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by McGinnis, Sr. et al. (US Patent No. 6,120,377).

McGinnis et al. disclose a gaming machine with a video display and a game control means arranged to control images displayed. The game control means has at least one random event to be

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displayed and if a predefined winning event occurs, the machine awards a prize. The display means has a plurality of movable carriers which are video simulations of actual carriers and each carrier carries a representation of at least one polyhedral element having a plurality of faces which are visible at any one time with indicia being carried on each face and the indicia which are visible at a rest condition are used in determining winning events (FIG 5).

Regarding claim 2, as disclosed above the display is video with the carriers being that of video simulations of a carrier.

Regarding claim 3, each carrier has more than one element.

Regarding claim 4, the elements are spaced from each other on each carrier such that only one polyhedral element is visible at a time when the carrier is at rest.

Regarding claim 5, the game is a spinning reel game.

Regarding claim 6, the carrier is a simulated reel and carries at least one of the elements.

Regarding claim 8, the elements are movable with respect to their associated carriers.

Regarding claim 9, the elements can rotate about at least two axes, which would be evident by their shape. They rotate parallel to end in their position as well as transverse in order to select the symbol.

Regarding claim 10, the element is displayed in three-dimensional format so at least three faces are visible.

Regarding claim 11, the indicia carried on the faces are standard symbols relating to the game.

Regarding claim 13, the elements are substantially cubic in shape (FIG 4).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 4 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnston (GB 2253300).

What Johnston discloses has been discussed above and is incorporated herein.

Johnston does not disclose the usage of special symbols on the polyhedral elements. However, such symbols are notoriously well known in the art as parts of such games. It would have been obvious to one of ordinary skill in the art to incorporate special symbols such as a wild into the system of Johnston. One of ordinary skill in the art would be motivated to make this incorporation as to provide the player with further chances to win which will in turn provide the player with motivation to play the machine as the usage of special symbols will attract the player with the perception of greater winning chances.

Further, regarding claim 4, Johnston does indeed disclose only one element in each window as per the spacing of the elements. Thus, one element is visible at a time in each part of the display. Johnston discloses a number of different ways to display this (FIG 4b and 4a). However, though only one is shown per window, there is more than one element visible in the entire display. However, it would be obvious to a skilled artisan that control of the display is a design choice and if one so desires, the display of Johnston could be set up in such a manner that only one element is

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shown on each reel at a time, such as by making it a single reel game. A skilled artisan would be motivated to make this incorporation in order to provide a small amount of information at a time, thus not confusing the player and making the game easier to use and understand thus motivating a beginner to use it as beginners are more likely to play on games they find simple and easy to understand. The display manner is a design choice motivated by the needs and desires of the designer.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over McGinnis, Sr. et al. (US Patent No. 6,120,377).

What McGinnis, Sr. et al. disclose has been discussed above and is incorporated herein.

McGinnis, Sr. et al. do not disclose the usage of special symbols on the polyhedral elements. However, such symbols are notoriously well known in the art as parts of such games. It would have been obvious to one of ordinary skill in the art to incorporate special symbols such as a wild into the system of McGinnis, Sr. et al. One of ordinary skill in the art would be motivated to make this incorporation as to provide the player with further chances to win which will in turn provide the player with motivation to play the machine as the usage of special symbols will attract the player with the perception of greater winning chances. -

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent No. 6,123,333: Method of playing a wagering game with polyhedral elements used in a manner of a spinning reel game.

US Patent No. 5,344,145: Spinning reel game with three-dimensional elements for use in the view of the window.

US Patent No. 6,213,876: Dice game with three-dimensional elements to represent winning outcomes.


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US Patent No. 6,305,686: Game with three-dimensional elements in the form of dice. Also shown how it is known to use only one winning line, thus having only one element visible at one time.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Marks whose telephone number is (703)-305-7497. The examiner can normally be reached on Monday - Thursday (7:30AM - 5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa J Walberg can be reached on (703)-308-1327. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


cmm
February 17, 2004


MICHAEL O'NEILL
PRIMARY EXAMINER